REMARKS

In response to the Office Action mailed July 14, 2003, Applicant has amended the application as above. No new matter is added by the amendments as discussed below. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the amendments and the remarks set forth below.

Discussion of Claim Amendments

Claims 1, 10-11 and 13-15 have been amended. Claims 16-18 have been added. Upon the entry of the amendments, Claims 1-18 are pending in this application. The amendments to Claims 1, 10-11 and 13-14 are merely made for clarification and do not narrow the scope of protection. The amendments to Claim 15 are supported, for example, by the specification at page 3, lines 10-12. New Claim 16 is supported, for example, by Figure 3 and the specification at page 5, line 19 and page 6, line 1. New Claims 17 and 18 are supported, for example, by Figure 10 and the specification at page 10, lines 10-14. Thus, no new matter is added by the amendments. Applicant respectfully requests the entry of the amendments.

Discussion of Claim Rejections Under 35 U.S.C. § 112, ¶ 2

The Examiner has rejected Claims 1-15 under 35 U.S.C. § 112, second paragraph as being indefinite. As discussed below, the rejected claims now are clear and definite. Withdrawal of the rejections is respectfully requested.

The Examiner asserts that with regard to Claims 1 and 10, the essential structural relationships between the first entity, second entity, detector and function select mechanism are not provided in those claims. Applicant respectfully disagrees with the Examiner in this regard. The essential structural relationships between those elements are clearly recited in each of the claims as discussed below.

Each of Claims 1 and 10 (also Claim 11) recites: 1) a first entity having first and second functions, a detector, and a function select mechanism, 2) a second entity having one of the first and second functions, 3) an interface for *connecting* the first entity and the second entity, 4) the detector *detects a function of the second entity* when connected to first entity, and 5) the function select mechanism *selects one function* from the two *functions in the first entity in response to the*

detected function. That is, both of the recited interface and detector provide a connection or relationship between the first entity and the second entity. In addition, the function select mechanism provides a connection or relationship between the detector and the first entity. In view of the above, Applicant respectfully submits that each of Claims 1, 10 and 11 recites all essential structural relationships.

The Examiner also asserts that with regard to Claims 13 and 15 the language "selecting one out of the first and second functions" is unclear. In order to expedite the prosecution of the application, Applicant has amended the indicated language to read "selecting one function from the first and second functions." In addition, although not pointed out by the Examiner, Applicant has made the same revisions to the same limitation in Claims 1 and 10 for the purpose of consistency.

The Examiner notes that with regard to Claim 13 the terms "the first resistance" and "the second resistance" lack a antecedent basis. In reply, Applicant has amended the terms to "the first resistor" and "the second resistor," respectively. In view of the above, each term has a proper antecedent basis.

Discussion of Claim Rejections Under 35 U.S.C. § 102(e)

The Examiner has rejected Claims 1-15 under 35 U.S.C. § 102(e) as being anticipated by Oguma (U.S. Patent No. 6,516,205). Claims 13 and 14 have been indicated by the Examiner to be allowable if rewritten to overcome the § 112, second paragraph rejection. As discussed above, Claim 13 has been amended to overcome the § 112 rejection. Claim 14 depends on Claim 13. Thus, Claims 13 and 14 are allowable over the prior art. Claims 1-12 and 15 are not anticipated by the Oguma reference as discussed below.

Standard of Anticipation

"For a prior art reference to anticipate a claim under 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference." *Diversitech Corp. v. Century Steps, Inc.*, 850 F.ed 675, 677, 7 USPQ 2d 1315, 1317 (Fed. Cir. 1988).

<u>Discussion of the Oguma Reference</u>

Oguma discloses that a portable terminal (5) functions as either a USB bus manager or a USB bus slave depending on the state of a host PC (1) (column 2, lines 2-4). The portable terminal (5) functions as a USB bus manager when the host PC (1) is either not connected to the portable terminal (5) or in the suspended state (non-operation state) (column 3, lines 32-34, column 4, line 65 through column 5, line 18, and column 5, lines 19-44; Figures 2 and 3). Also, the portable terminal (5) functions as a USB bus slave when the host PC (1) is connected to the portable terminal (5) and in the operation state (column 3, lines 64-65, column 5, line 45 through column 6, line 6; Figures 2 and 3).

<u>Discussion of Patentability of Independent Claims 1, 10, 11 and 15</u>

Each of independent Claims 1, 10 and 11 recites, among other things, that the detector detects *a function of the second entity* when connected to the first entity, and the function select mechanism *selects one function* from the first and second functions in the first entity *in response to the detected function* of the detector. Independent Claim 15 recites, among other things, *detecting a function of the second entity* and *selecting one function* from the first and second functions in the first entity *in response to the detected function.* However, the Oguma reference does not disclose the above recited features as discussed below.

1. Oguma Does Not Show the Detector or Detecting a Function of the Second Entity

The Examiner asserts that a device (6) and a host PC (1) correspond to the first and second entities of the claimed invention, respectively. Applicant assumed that what the Examiner meant to compare with the first entity was a portable terminal (5) rather than a device (6). Even if the Examiner's assertion is correct, the Oguma reference does not show the detector recited in each of Claims 1, 10 and 11 as discussed below.

The portable terminal (5) detects whether or not the host PC (1) is connected to the portable terminal (5) via a voltage detecting circuit (64), or whether the host PC (1) is in the non-operation state or in the operation state via a level detecting circuit (61) (Figure 3). Neither of the detecting circuits (61, 64) satisfies the definition of the recited detector, which detects *a function of the second entity.* The voltage detecting circuit (64) only detects whether the host PC

(1; acknowledged by the Examiner to be the second entity) is connected to the terminal (5). Applicant respectfully submits that the detecting of a connection to the PC (1) is not relevant to detecting a function of the host PC (1).

The level detecting circuit (61) only detects a current state of the host PC (1) as to whether the PC (1) is either in an operation mode or in a non-operation mode. Applicant respectfully submits that the detecting of a current state of the PC (1) is not relevant to detecting a function of the host PC. Actually, the system of the Oguma reference does not need to detect a function of the host PC (1) because the function of the host PC (1) is predetermined to be a host function.

In addition, even if one of the devices (3, 4, 6) is arguably regarded as the recited second entity, neither of the detecting circuits (61, 64) is functionally related to the devices (3, 4, 6), much less detecting a function of the devices (3, 4, 6). As clearly shown in Figure 3, neither of the detecting circuits (61, 64) is even connected to any of the devices (3, 4, 6). Thus, the Oguma reference does not show the detector which detects *a function* of the second entity when connected to the first entity recited in each of Claims 1, 10 and 11. Similarly, the Oguma reference does not show "detecting *a function* of the second entity when connected to the first entity" recited in Claim 15.

2. Oguma Does Not Show the Function Select Mechanism or Selecting One Function In Response to the Detected Function

Oguma does not show the recited function select mechanism which selects one function from the first and second functions in response to *the detected function* of the detector. The Oguma reference, instead, discloses that a bus manager circuit (62) (arguably "function select mechanism") of the portable terminal (5) selects either a bus manager function or a bus slave function based on the detected state of the host PC (1). That is, when the host PC (1) is connected to the portable terminal (5) and in the operation state, the bus manager circuit (62) selects a bus slave function so that the terminal (5), functioning as a bus slave, only passes communication signals between the host PC (1) and the device (6). Alternatively, when the host PC (1) is either not connected to the portable terminal (5) or in the non-operation state, the bus

manager circuit (62) selects a bus manager function so that the terminal (5) functions as a bus manager to the device (6).

In summary, the bus manager circuit (62) selects one of the bus manager function and the bus slave function based on the (detected) *current state of the host PC (1)*. However, the bus manager circuit (62) is not functionally related to detecting a function of either the host PC (1) or the devices (3, 4, 6). Furthermore, as discussed above, neither of the detecting circuits (61, 64) needs to, nor does, detect a function of the host PC (1). Therefore, the bus manager circuit (62) actually does not select one of the functions *in response to a function* of the host PC (1).

In view of the above discussion, Oguma does not show the function select mechanism which selects the first or second function in response to *the detected function* recited in each of Claims 1, 10 and 11. Similarly, the Oguma reference does not show *selecting one function* from the first and second functions in response to *the detected function* recited in Claim 15.

3. Summary

In view of the above, Oguma shows neither of the recited detector and function select mechanism of independent Claims 1, 10 and 11. In addition, Oguma shows neither the recited "detecting" and "selecting" of independent Claim 15. Thus, the Oguma reference does not show every element of the claimed invention. Applicant respectfully submits that Oguma does not anticipate Claims 1, 10, 11 and 15. Furthermore, since Oguma does not teach or suggest the recited features, none of independent Claims 1, 10, 11 and 15 would have been made obvious over the reference, either. Therefore all independent claims are patentable over the Oguma reference.

Discussion of Patentability of Dependent Claims

Claims 2-9 and 12 depend from base Claim 1 or 11, and further define additional technical features of the present invention. In view of the patentability of their base claims, and in further view of the additional technical features, the dependent claims are patentable over the cited reference. Withdrawal of the rejections is respectfully requested.

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 4-6, 8-9 and 12 under 35 U.S.C. § 103 (a) as being

unpatentable over Oguma. As discussed above, independent Claims 1 and 11 are patentable over the Oguma reference. Claims 4-6, 8-9 and 12 depend from base Claim 1 or 11, and further define additional technical features of the present invention. In view of the patentability of their base claims, and in further view of their additional technical features, the dependent claims are patentable over the cited reference. Withdrawal of the rejections is respectfully requested.

Discussion of Patentability of New Claims 16-18

New Claim 16 recites the detector and function select mechanism of Claim 1, and additionally recites a first entity having a host function and a device function, and a second entity having a device function. As discussed above, the host PC (1) of the Oguma reference is predetermined to have a host function, and cannot be the recited second entity having a device function. Furthermore, even if one of the devices (3, 4, 6) can be regarded as the recited second entity, neither of the detecting circuits (61, 64) is functionally related to the devices (3, 4, 6; Figure 2), much less detecting a function of any of the devices (3, 4, 6). Thus, it is very clear that Oguma does not show the detector of new Claim 16. In view of patentability of Claim 1 and in further view of the above additional features, new Claim 16 is patentable over the Oguma reference.

New Claim 17 recites the detector and the function select mechanism of Claim 1, and additionally recites a first entity having a host function and a device function, and a second entity having a host function and a device function. Oguma does not disclose or teach the recited second entity which has both a host function and a device function. Neither of the host PC (1) and the devices (3, 4, 6) can be the recited second entity for the following reasons.

As discussed above, the host PC (1) is predetermined to have a host function, and does not have a device function. In addition, the devices (3, 4, 6) only perform a device function to either the host PC (1) or the portable terminal (5), and do not perform a host function. Thus, Oguma does not disclose or teach the recited second entity which has both a host function and a device function. In view of patentability of Claim 1, and in further view of the additional features in connection with the second entity, new Claim 17 is patentable over the Oguma reference.

New Claim 18 depends from base Claim 17, and further defines additional technical features of the present invention. In view of the patentability of its base claim, and in further view of its additional technical features, the new dependent claim is patentable over the cited reference.

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<u>CONCLUSION</u>

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In view of Applicant's amendments to the claims and the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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